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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,635	10/09/2001	Juan Antonio Barrio Calle	B-4330 619132-0	1023

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Richard P. Berg, Esq.
c/o LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles, CA 90036-5679

EXAMINER

HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,635

Applicant(s)

CALLE ET AL.

Examiner

Jacqueline V. Howard

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of abbreviation "SEBS" in claim 1 renders the claims indefinite. The name of the intended material should be written out.

Claim 4 recites the limitation "the styrene butadiene radial copolymer" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the copolymer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the polymer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 provides for the use of a composition as a cable filling material, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35

Art Unit: 1764

U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koblitz et al (5,844,021).

Patentee teaches a sealant composition comprising a thermoplastic polymer and an extender (col. 5, lines 34-39). The composition may be used as cable filling material (col. 2, lines 62-64). The preferred extender is mineral oil (col. 16, line 52). The polymeric material is described at col. 12, lines 40 through col. 13, line 52. The polymeric material may have a radial structure and may be a hydrogenated styrene block polymeric material.

Applicants claim a composition for use as a cable filler comprising a mineral or synthetic oil and a radial hydrogenated styrene block synthetic rubber.

It is the examiner's position that the claimed invention would be prima facie obvious in view of the cited prior art. It would be obvious to use a composition comprising the claimed components as a cable filler because the prior art teaches compositions comprising those same components may be used as a cable filler. It is not unobvious to follow the teaching of the prior art.

Art Unit: 1764


Claims 1-3 and 5 to 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (4,351,913) or Sabia (4,176,240) combined with Brauer (5,358,664).

Both Patel and Sabia teach composition used as a cable filling material comprising a styrene block copolymer, a mineral oil and polyethylene wax. Brauer teaches radial styrene block copolymers may be used in cable filler compositions. It would be obvious to one of ordinary skill in the art to use the radial styrene block copolymer of Brauer in the cable filler composition of Patel or Sabia because the substitution of art recognized equivalents as shown by Brauer would have been within the level of ordinary skill in the art.

The references cited but not applied further teach styrene block copolymers as cable fillers.

Any inquiry concerning this communication should be directed to J. V. Howard at telephone number (703) 308-2514.

J. V. Howard/mn
April 1, 2003


J. V. HOWARD
PRINCIPAL EXAMINER
GROUP 100